APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,484	06/20/2001	Jan Arwald	205409US2PCT	5895

				EXAMINER
22850	7590	12/29/2004		GREY, CHRISTOPHER

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

ART UNIT	PAPER NUMBER
2667	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/806,484	ARWALD ET AL.
	Examiner	**Art Unit**	
	Christopher P Grey	2667	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 June 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 June 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Drawings

1.   The drawings are objected to because:

(a) Element 603 in fig 6 incorrectly spells accessible

(b) Element 613 in fig 6 incorrectly spells authorize

(c) Element 615 in fig 6 incorrectly spells router

(d) Page 6 of the specification states that the adapters 21 a-g are labeled as H,

where in fig 2, they are depicted by h

(e) Page 8 of the specification states that in Fig 2 the database is labeled as

element 37, where in fig 2, the database is labeled element 39

(f) Elements 21-29 should be labeled network A-E, element 31 should be labeled

Service F, and element 33 should be labeled Node object G.

Corrected drawings are required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2.   Claim 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the enablement requirement. The claim(s) contains subject matter that was not

described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 and 7 claim a first object being one of a number of networks, and an electrical

distribution network. The specification fails to provide an enabling disclosure of how the

first object is a combination of two networks as recited in claims 1 and 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Danielson et al. (US 5239662) in view of Mendelson (US 6343083) in further view of

(WO 98/37724)

<u>Claim 1, 7</u>   Danielson et al. (Danielson 'hereinafter ') discloses within a

communication system, a controller (device) configured to establish communication

between different/non-compatible locations/networks (elements 34-37 and 31-1-N in fig

3). Danielson discloses these locations/networks using different communication

protocols. Danielson discloses devices (elements 21 a-n in fig 2) being coupled to the

controller via adapters (elements 22a-n in fig 4), which convert (translate) the received

protocol to a common protocol (Col lines 22-68). Danielson does not disclose a protocol

coordination mechanism that compares attributes of different protocols supported by a

first adapter and a second adapter when establishing the communication session

between the first object and second object. Danielson does not disclose a database

having a list of subscribers with associated calling numbers.

Mendelson discloses an invention designed at establishing a connection across a connection- oriented network. Mendelson also discloses an access network controller containing a cache of tables containing IP to MAC translation addresses and other parameters (Col 12 lines 26-59) pertaining to the networks (elements 112 and 110 in Fig 1). The access network controller compares the parameters within the cache in order to translate the specified destination IP address to a corresponding destination address (Col 13 lines 12-15). Mendelson also discloses an Ethernet, ATM and LAN network (Col 5 lines 25-49). Although one skilled in the art can appreciate the cache of tables disclosed by Mendelson including a list of subscribers, it is not specifically disclosed within the specification.

Sylvian et al. (Sylvian 'hereinafter') discloses within a communication system a plurality of communication networks, each utilizing its own protocol. Furthermore, Sylvian discloses a database (element 250 in fig 3) that stores subscription data (disclosed on page 9 lines 7-27).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the controller disclosed by Danielson with the controller disclosed by Mendelson, aimed towards comparing parameters in order to translate protocols. The motivation for the modification of these teachings is to achieve better management of connections (see abstract). Furthermore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the teachings of both Danielson and Mendelson with the subscription and service list/database disclosed by

Sylvian. The motivation for this modification is to provide management of multiple

networks and services in a more efficient manner (disclosed on page 3 lines3-5).

Claim 2, 8   Danielson discloses a central site/controller (element 30 in fig 3) that

communicates with different locations (objects), and routes/switches the information

accordingly (Col 4 line 22-38). The motivation is the same as that for claim 1 and 7.

Claim 3, 9   Danielson discloses several devices being interfaced with the

communication controller (router) via adapters (elements 22 A-N in fig 2). This controller

is designed to control and route (router) information (disclosed in Col 4 lines 53-68).

Danielson does not disclose a database containing a subscriber list and numbers.

Danielson also does not disclose a control signal being sent to establish a protocol to be

employed.

Sylvian discloses a main database containing subscriber information (page 3

lines 8-17 and page 9 lines 7-27). Sylvian also discloses when a new subscriber

attempts to connect to a network, the subscriber accesses the main database, where

information (protocol info) is gathered about the new device and communicated (control

signal) to the affected networks/devices Page 13 line 1-17).

The motivation is the same as that for claim 1 and 7.

Claim 4, 10   Danielson does not disclose the entries within the database being

changed when the subscriber moves from one object affiliation to the other.

Sylvian discloses the maintenance of subscriber data, location and activity

information, and no need for changing calling numbers (Page 8 lines 12-18 and page 16

lines 1-23). The motivation is the same as that for claim 1 and 7.

Claim 5, 11   Danielson does not disclose the entries within the database having

associated calling numbers for a particular subscriber with an object and a net number

for said subscriber.

Sylvian discloses several different assigned numbers for a given subscriber

(page 16 lines 1-23). The motivation is the same as that for claim 1 and 7.

Claim 6, 12   Danielson does not disclose associating one calling number for a

subscriber with a net number and another number at which the subscriber is available.

Sylvian discloses a number of different numbers being assigned to each

subscriber, where the different numbers represent different specifications (net and

availability, page 16 lines 1-23). The motivation is the same as that for claim 1 and 7.

Claim 13, 27   Danielson et al. (Danielson 'hereinafter ') discloses within a

communication system a method comprising a controller (device) configured to

establish communication between different/non-compatible locations/networks

(elements 34-37 and 31-1-N in fig 3). Danielson discloses devices (elements 21 a-n in

fig 2) being coupled to the controller via adapters (elements 22a-n in fig 4), which

convert (translate) the received protocol to a common protocol (Col lines 22-68).

Danielson does not disclose identifying attributes of both objects.

Mendelson discloses an invention designed at establishing a connection across a

connection- oriented network. Mendelson also discloses an access network controller

containing a cache of tables containing IP to MAC translation addresses and other

parameters (Col 12 lines 26-59) pertaining to the networks (elements 112 and 110 in

Fig 1). The access network controller compares the parameters within the cache in

order to translate the specified destination IP address to a corresponding destination address (Col 13 lines 12-15).

Therefore it would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the controller disclosed by Danielson with the controller disclosed by Mendelson, aimed towards comparing parameters in order to translate protocols. The motivation for the modification of these teachings is to achieve better management of connections (see abstract).

Claim 14   Danielson discloses converting (translate) a received protocol to a common protocol (Col lines 22-68). Danielson does not disclose determining whether an intermediate translating step is required.

Mendelson discloses a controller that makes an initial translation, and furthermore determines if the destination address is native or not, and translates as necessary (Col 13 lines 12-15).

The motivation is the same as that for claim 13.

Claim 15   Danielson discloses converting (translate) a received protocol to a common protocol (Col lines 22-68). Danielson does not disclose the predetermined protocol being different from the native protocol and another protocol.

Mendelson discloses a controller that makes an initial translation, and furthermore determines if the destination address is native or not, and translates as necessary (Col 13 lines 12-15).

The motivation is the same as that for claim 13.

Claim 16   Danielson discloses devices (elements 21 a-n in fig 2) being coupled to the controller via adapters (elements 22a-n in fig 4), which convert (translate) the received protocol to a common protocol (Col lines 22-68). Furthermore, Mendelson discloses a conversion of protocol exclusively at the adapters (disclosed in Col 8 line 60- Col 9 line 3). The motivation is the same as that for claim 13.

Claim 17   Danielson does not disclose determining whether an activity in the first object requires communication outside of the object and initiating a sending step when the activity takes place outside of the first object.

Sylvian discloses when a subscriber enters a new coverage area (activity), a location update is communicated (sending step) to an HLR (Col 12 lines 10-21).

The motivation to modify the teachings of Danielson and Mendelson with the subscriber profile (HLR) disclosed within Sylvian's invention is to manage and control subscriber information and services.

Claim18   Danielson discloses translating the information into a format that is supported by the second adapter (Col lines 22-68), but not for translating the format into another protocol.

Mendelson discloses an initial translation, and furthermore determines if the destination address is native or not, and translates as necessary (Col 13 lines 12-15).

The motivation is the same as that for claim 13.

Claim 19   Danielson and Mendelson do not teach establishing a profile for future communication sessions.

Sylvian discloses a subscriber profile (element 310 in Fig 5) for establishing a

connection (page11 line 29- page 12 line 9).

The motivation to modify the teachings of Danielson and Mendelson with the

subscriber profile disclosed within Sylvian's invention is to manage and control

subscriber information and services.

Claim 20   Danielson does not disclose a first object establishing a second object in

which services for future communication will be used.

Sylvian discloses parameters being stored within the subscriber profile including

the type of service, for which the connection between the first device and second device

are determined (page 11 line 29- page 12 line 9). The motivation is the same as that for

claim 19

Claim 21   Danielson discloses a form of protocol coordination mechanism, whereby

a number of step/rules take place in order for communication to take place (disclosed in

Col 5 lines 1-32). The motivation is the same as that for claim 13.

Claim 22   Danielson does not teach a user profile.

Sylvian discloses a subscriber profile (element 310 in Fig 5) for establishing a

connection (page11 line 29- page 12 line 9).

The motivation to modify the teachings of Danielson and Mendelson with the

subscriber profile disclosed within Sylvian's invention is to manage and control

subscriber information and services.

Claim 23   Danielson discloses a form of protocol coordination mechanism,

whereby a number of step/rules take place in order for communication to take place

(disclosed in Col 5 lines 1-32). Furthermore, Sylvian discloses a subscriber profile (element310 in fig 5) for authentication and authorization, and another database for updating location. One skilled in the art can appreciate the need for specific rules.

The motivation is the same as that for claim 22

Claim 24   Danielson does not disclose indicating conditions for linking the first object to the second object by considering available factors.

Sylvian discloses a subscriber profile that indicates several different conditions for linking, including preference data such as cost of routing (page 11 lines 29-page 12 line 9).

The motivation to modify the teachings of Danielson and Mendelson with the subscriber profile disclosed within Sylvian's invention is to manage and control subscriber information and services.

Claim 25   Danielson does not disclose registering agreements and conditions that are mutually agreed upon.

Sylvian discloses a subscriber profile that indicates preference data (registering agreement and conditions) for the linking between objects (page 11 lines 29-page 12 line 9). The motivation is the same as that for claim 24.

Claim 26   Danielson discloses the controller (element 20 in fig 2) being accessible to a number of devices (elements 21 A-N). The motivation is the same as that for claim 13.

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

(a) Ramasubramani et al. (US 6507589) discloses a method and apparatus for routing

between network gateways and service centers. Ramasubramani discloses a gateway

(controller), a router and a routing table (list).

(b) Gardner et al. (US 5691984) discloses a brouting switch that allows communication

between external systems with differing protocols.

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Christopher P Grey whose telephone number is

(571)272-3160. The examiner can normally be reached on 6:30-3:00.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chi Pham can be reached on (571)272-3179. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

        Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Grey
Examiner
Art Unit 2667

AFSAR QURESHI 12/23/2004
PRIMARY EXAMINER